

This Opinion is Not a
Precedent of the TTAB

Mailed: October 24, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Stratio Big Data, Inc.

v.

Stratio Automotive Inc.

—
Opposition No. 91244363

—
Marie Anne Mastrovito of Womble Bond Dickinson
for Stratio Big Data, Inc.

Lauren B. Emerson and Lori L. Cooper of Leason Ellis LLP
for Stratio Automotive Inc.

—
Before Wellington, Adlin and Cohen, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Stratio Automotive Inc. seeks registration of STRATIO with a design –



– for the following goods and services:

computer software for remote monitoring of devices for measuring automotive vehicle performance; downloadable software for measuring, detecting and monitoring of automotive performance; instruments for measuring, detecting and monitoring of land vehicle performance namely (sic) water temperature gauges, air fuel/ratio gauges, boost gauges, vacuum gauges, exhaust gas temperature gauges, oil pressure gauges, oil temperature gauges, coolant temperature gauges or engine RPM

gauges; diagnostic apparatus for testing automobiles; sensors and detectors for measuring, detecting and monitoring automotive land vehicles performance namely of oil pressure sensor, oil temperature sensor, coolant temperature sensor or engine RPM sensors; electronic controls for gasoline, diesel or electric engines for monitoring and checking motor vehicle and engine performance for repair and maintenance needs; electric wire harnesses for vehicle repair and maintenance; vehicle electronic controls to remotely monitor and control motor vehicle engine systems, energy systems, lighting systems, braking systems, climate systems, or fuel systems, in International Class 9;

land vehicle structural parts; land vehicle parts in the nature of wire harnesses, namely, wires, terminals and connectors bundled together to transmit electric power and signals to electric or electronic equipment mounted on the body parts of automobiles; land vehicle console parts, namely, wiring harnesses for control, monitoring and protection of industrial gasoline and diesel engines; sensors for land vehicles, namely, electric power steering torque sensors, sold as a component of the power steering system; anti-theft, security and safety devices and equipment for vehicles namely anti-theft alarms and anti-theft devices for vehicles; back-up warning alarms for vehicles; motor vehicle alarm systems, in International Class 12; and

vehicle service, repair, maintenance and refueling; inspection of automobiles and their parts prior to maintenance and repair; arranging for the maintenance of motor land vehicles; providing information relating to the repair of land vehicles; information and consultancy services relating to vehicle repair; advisory services relating to the maintenance and repair of vehicles; consultancy relating to the repair, maintenance and refueling of vehicles, in International Class 37.¹

¹ Application Serial No. 87679750, filed November 10, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce. The application includes this description of the mark: “The mark consists of a red circle in the middle of a semi-circle which is orange on one side and moves into being dark red and then to red with the word ‘STRATIO’ to the right of the circle in black.

In its notice of opposition, Opposer Stratio Big Data, Inc. alleges prior use and registration of STRATIO, in standard characters, for:

computer software for use in the field of business intelligence gathering and management, business analytics, software application monitoring and analysis, web content customization and target marketing; computer software for the collection, editing, organizing, modifying, analyzing and generation of reports of data and information, in International Class 9;

data processing services, in International Class 35; and

data mining; data warehousing; software development in the field of business intelligence, business analytics, software application monitoring and analysis, web content customization and target marketing; information technology consulting services in the field of business intelligence, business analytics, software application monitoring and analysis, web content customization and target marketing, in International Class 42.²

As grounds for opposition, Opposer alleges that use of Applicant's mark would be likely to cause confusion with Opposer's mark.

In its amended answer and counterclaim, Applicant denies the salient allegations in the notice of opposition. In addition, as an alternative to its denial of likely confusion arising out of the parties' use of their marks for the goods and services set forth above, Applicant counterclaims to partially cancel Opposer's pleaded registration under Section 18 of the Trademark Act, 15 U.S.C. § 1068.

Specifically, Applicant alleges in support of its alternative counterclaim that Opposer's goods and services "are not directed at the vehicle and automotive channel

² Registration No. 4736124, issued May 12, 2015; Section 8 declaration accepted.

of trade, nor to consumers in the transportation or automotive industry ... Opposer does not use its Mark in connection with the repair, diagnosis, or maintenance of vehicles.” 18 TTABVUE 4³ (Answer and Counterclaim ¶ 14). Accordingly, if “necessary to avoid a likelihood of confusion and dismiss the instant Opposition,” Applicant requests adding to Opposer’s identification of goods and services in Classes 9 and 42 “the exclusionary language ‘none of the foregoing in connection with the repair, diagnosis or maintenance of vehicles,’” or “such other language as the Board deems fit.” *Id.* at 4-5 (Answer and Counterclaim ¶ 17). Relatedly, as explained below, Applicant filed a motion to amend its own application by deleting certain goods and services therefrom, and a decision on that motion was deferred until final decision. 11 and 16 TTABVUE. Opposer denies the salient allegations in Applicant’s alternative counterclaim, and contests Applicant’s motion to amend the goods and services identified in the involved application unless judgment is entered with respect to any deleted goods and services.

I. The Record and Evidentiary Objections

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application. In addition, Opposer introduced:

Testimony Declaration of Ernesto Joaquin Funes
Rodriguez de Llano, its Vice President of International

³ Citations to the record are to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

Affairs, and the exhibits thereto (“Funes Dec.”). 23-25 TTABVUE.

Notice of Reliance (“NOR”) No. 1 on Applicant’s discovery responses (“Opp. NOR 1”). 26 TTABVUE.

NOR No. 2 on printed publications and Internet printouts (“Opp. NOR 2”). 27 TTABVUE.

Rebuttal Testimony Declaration of Mr. Funes Rodriguez de Llano, and the exhibits thereto (“Funes Reb. Dec.”). 47 TTABVUE.

Rebuttal NOR on printed publications and Internet printouts (“Opp. Reb. NOR”). 48 TTABVUE.

Applicant introduced:

Testimony Deposition on Written Questions of Mr. Funes Rodriguez de Llano, and the exhibits thereto (“Funes Tr.”). 40 TTABVUE.

NOR on Opposer’s discovery responses, printed publications and Internet printouts (“App. NOR 1”). 44 TTABVUE.

Testimony Declaration of Ricardo Margalho, Co-Founder of STRA, S.A., Applicant’s parent company, and Applicant’s Chief Executive Officer (“CEO”), and the exhibits thereto (“Margalho Dec.”). 45 (confidential version) and 46 TTABVUE.

Rebuttal NOR on Internet printouts and third-party registrations (“App. Reb. NOR”). 49 TTABVUE.

Rebuttal Testimony Declaration of Mr. Margalho and the exhibit thereto (“Margalho Reb. Dec.”). 50 TTABVUE.

Shortly after Opposer’s initial testimony period ended, Applicant filed a motion to strike the Funes Declaration and some of the exhibits thereto. 28 TTABVUE. The Board deferred consideration of the objections to the declaration as a whole and the

hearsay objections to Exhibits B and D1 until final decision. 33 TTABVUE 2. The Board also overruled Applicant's various additional objections to Exhibits B and D1, and sustained Applicant's non-hearsay objections to Exhibit D2.

Applicant essentially renewed its motion to strike the Funes Declaration and Exhibits B and D1 thereto in its Trial Brief. 53 TTABVUE 40-42. Applicant's objection to the entire declaration, 53 TTABVUE 41, is based on nothing more than a stray vertical line appearing to the left of the last two lines of Paragraph 14 of the Funes Declaration, 23 TTABVUE 4. Applicant contends that the line is related to "track changes." The motion to strike is denied and the objection is overruled because the witness signed the declaration with the line, which has no English language meaning (and Applicant does not contend otherwise). By contrast, the rest of the declaration is legible, without "track changes" or other markings, in plain English and Applicant's officer declares under penalty of perjury that it is accurate.⁴

Applicant's objection to Paragraphs 21-23 of the Funes Declaration under Fed. R. Evid. 603, 53 TTABVUE 41, is also overruled because the cited Rule requires "an oath or affirmation to testify truthfully," and Opposer complied. In fact, the witness provided testimony "based on my own personal knowledge," 23 TTABVUE 2, under penalty of perjury, i.e. an "oath or affirmation to testify truthfully." *Id.* at 7. Applicant

⁴ All parties occasionally file documents with typos or other mistakes that have no substantive impact. Seeking advantage when an opponent's filing contains this type of irrelevancy is discouraged. Indeed, if everyone did it, it would take longer for the Board to issue decisions, and once issued, the decisions would include distracting assessments of minutiae. The Board's (and hopefully the parties') desired focus is on trademark registration.

contends that the witness “lacks personal knowledge of Applicant, Applicant’s goods and services or its business operations,” 53 TTABVUE 41, but in the paragraphs in question the witness testified not about Applicant or its operations generally, but instead about Applicant’s publicly-available website, and provided his assessment thereof. The Board is capable of reviewing the admissible portions of the website that Opposer submitted, and distinguishing information from the website from the witness’s opinion of the website material.

Applicant’s objections to Exhibits B and D1 to the Funes Declaration, 28 TTABVUE 2-3 and 53 TTABVUE 41-42, are overruled. The witness authenticated the documents, and affirmed that the portion of Opposer’s website in question reflects “further details regarding [Opposer’s] goods and services.” Opposer. 23 TTABVUE 4 (Funes Dec. ¶ 16). Applicant’s apparent contention that a party’s officer may not introduce the party’s website into evidence through testimony is novel, but erroneous. We have considered what the parties’ admissible website evidence shows on its face, as well as probative witness testimony about the parties’ admissible website evidence that is based on personal knowledge.

Applicant’s objection to the English translation of Exhibit 4 to the Funes Rebuttal Declaration, 53 TTABVUE 41-42, is overruled. The translated document rebuts portions of the Margalho Declaration. 46 TTABVUE 8 (Margalho Dec. ¶¶ 35-37).

Turning to Applicant’s objections made for the first time in its Trial Brief, we overrule the objections to Exhibits 1-4 of Opposer’s NOR No. 2. 53 TTABVUE 42-45. While Applicant is of course correct that because these materials are not accompanied

by testimony, they may not be considered for the truth of the matters asserted therein, these types of materials have been admissible for what they show on their face for over 13 years. *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1037 n.14 and 1040 (TTAB 2010). Sometimes what Internet printouts and printed publications show on their face is relevant to trademark cases, including likelihood of confusion cases. *Harry Winston, Inc. & Harry Winston S.A. v. Bruce Winston Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014) (“such materials are frequently competent to show, on their face, matters of relevance to trademark claims (such as public perceptions), regardless of whether the statements are true or false. Accordingly, they will not be excluded outright, but considered for what they show on their face.”). *See also In re Ayoub Inc.*, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1467 n.30 (TTAB 2014). To the extent the articles address **trademark use** in foreign countries but not the United States, we have not considered them, but reports on **company activities other than trademark use** may be relevant even if the activities take place in a foreign country, and to that extent we have considered these exhibits.⁵

Applicant’s objections to the Funes Rebuttal Declaration and Opposer’s NOR No. 3, 53 TTABVUE 45-49, are overruled for reasons already stated. Specifically, Opposer’s foreign activities unrelated to trademark use may be considered for

⁵ Applicant’s reliance on *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) is misplaced. That case involved a discovery dispute in which the discovery requests in question were trademark-specific. *Id.* at 1611 (“Applicant argues that several discovery requests relate to applicant’s foreign trademark applications and registrations and other trademark rights and such requests are not relevant in an opposition proceeding.”).

whatever probative value they may have, and Internet printouts and printed publications are admissible under Trademark Rule 2.122(e). On the other hand, we sustain Applicant's objection to the portions of Paragraph 8 and Paragraph 10 of the declaration that relate to Grupo Detector and Heliotrope Technologies, because this is improper rebuttal and should have been part of Opposer's case-in-chief. For the same reason, we have not considered Paragraph 11 of the Funes Rebuttal Declaration.

As for Applicant's remaining objections, suffice it to say, "we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence." *Hunt Control Sys. Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011). *See also Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1200 (TTAB 2018) ("We also remind the parties that our proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.") (citing *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)).

II. The Parties

Opposer's goods and services are all data and "big data"⁶-related, and are offered to customers in a wide range of industries. Applicant's goods and services are focused on vehicles, and targeted specifically to companies that manage fleets of vehicles.

A. Opposer

Opposer's "software and related services enable businesses of all sizes to gather, manage, monitor, analyze and store" data. 23 TTABVUE 3 (Funes Dec. ¶ 11). Its software and services "can be used by virtually any industry, including, but not limited to telecom, banking, insurance, retail, utilities, transportation, manufacturing and remote diagnostics."⁷ *Id.* (Funes Dec. ¶ 12). Opposer "markets its services horizontally across all industries." *Id.* Its goods and services "enable users to apply Artificial Intelligence ('AI') to manage, analyze, visualize and interpret data in a simple working environment." *Id.* at 4 (Funes Dec. ¶ 17).

Opposer "has made sales presentations to automobile manufacturers," but it only names one, Toyota Spain. *Id.* (Funes Dec. ¶ 14). The Toyota Spain presentation "was

⁶ Mr. Funes testified that "big data" typically "refers to – to data sets that are too – too large or complex to be dealt with by – by traditional data processing technologies. They – they are usually the three V's, which are volume, variety, and velocity when referring to this type of data." 40 TTABVUE 13 (Funes Tr. 9). Mr. Funes's description is similar to the Investopedia definition of "Big Data," of which we take judicial notice ("investopedia.com/terms/b/big-data.asp"). According to Investopedia, "[b]ig data often comes from data mining and arrives in multiple formats." The Board may take judicial notice of encyclopedias such as Investopedia. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011).

⁷ According to Opposer's website, Opposer works "for large companies and multinationals in the sectors of banking, insurance, healthcare, telco, retail, energy and media." 47 TTABVUE 109.

made on or about the possibility of installing Stratio to help Toyota correlate the sales in their physical channel with all their activity on the online channel (marketing, web traffic, online ads, ...)." *Id.*

When asked whether any of Opposer's United States customers have "been in the vehicular repair or maintenance industry," Mr. Funes was vague and by his own admission "not fully sure":

Well, Nephila was an insurance company. So they were into insurance. So that might involve among the automotive industry. Not fully sure about that.⁸ And then we have another customer that's called Heliotrope Technologies that work in glass. And they produce this glass for use in housing and in vehicles. So you could say that they were also involved into the maintenance and automotive industry.

40 TTABVUE 19-20 (Funes Tr. 15-16).

In any event, an article entitled "Big Data in the Automotive Industry" states that "[t]hrough the use of Big Data technologies, automotive OEMs and other stakeholders are beginning to exploit vehicle-generated data assets in a number of innovative ways ranging from predictive vehicle maintenance and UBI (Usage-Based Insurance) to real-time mapping, personalized concierge, autonomous driving and beyond." 27 TTABVUE 8.

⁸ Opposer's website describes a "solution" Opposer provided to an insurance company, but the company is unnamed and thus it is not clear whether the company is Nephila. In any event, Opposer "built an AI solution to calculate fraud probability of an auto claim using all data sources and the data of the insurance inspector (including pictures of the car) to define the probability of fraud and give a real-time recommendation to insurance inspector to accept the claim or not." 47 TTABVUE 74.

B. Applicant

Applicant was formed after Mr. Margalho and a colleague missed an important meeting because their bus broke down. 46 TTABVUE 3 (Margalho Dec. ¶ 2). They wanted to “build a suite of products and services to predict and prevent vehicles from breaking down.” *Id.*

Applicant now offers a “real-time predictive fleet maintenance platform under the applied-for mark STRATIO.” *Id.* (Margalho Dec. ¶ 3). Its “mission is ‘zero downtime’ for fleet vehicles.” *Id.* Mr. Margalho testified that

[Applicant’s] offerings in the United States under its STRATIO mark at issue include subscription-based services for remote monitoring of vehicle performance (including through monitoring information from sensors detecting oil pressure, oil temperature, coolant temperature, and engine RPM) and facilitating vehicle repair and maintenance that utilizes both hardware and software to collect and analyze vehicular data for use in failure detection and predictive alerts.

Stratio leases specialized STRATIO brand hardware to businesses (called the Stratio Databox). Stratio Databox is a telematics equipment to be placed in trucks, buses, vans, and other vehicles for diagnostic purposes, including to monitor the performance of various sensors, components and systems. This equipment is configured by Stratio to suit each client’s needs, i.e. according to the specific vehicle makes and models. Through a proprietary web-based software application, Stratio leverages the information acquired via this equipment to enable customers to monitor vehicle performance and facilitate vehicle repair and maintenance through real time fault detection and predictive and automated maintenance.

Stratio’s fleet maintenance platform provides predictive intelligence to detect anomalies, faults, and potential breakdowns before they occur ...

Id. at 3-4 (Margalho Dec. ¶ 4-5).

While Applicant “itself utilizes artificial intelligence and processes data,” it does not “provide ‘AI solutions’ or ‘data management solutions’ to US customers. These are simply the processes, tools and components that we use to do what we do” 50 TTABVUE 3 (Margalho Reb. Dec. ¶ 2). Mr. Margalho analogizes Applicant’s use of machine learning for fleet management to Netflix’s use of machine learning to make film and television recommendations to customers, and Uber’s use of machine learning to calculate “surge pricing.” *Id.* (Margalho Reb. Dec. ¶ 3).

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021). Here, Opposer made its pleaded registration of record, 1 TTABVUE 8-11, and the registration establishes both that Opposer has a statutorily-protected interest and a reasonable belief in damage proximately caused if Applicant’s involved mark is registered. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes “standing”).

IV. Priority

Because Opposer's pleaded registration is of record, 1 TTABVUE 8-11, and Applicant has not counterclaimed to cancel it in full, but instead has only counterclaimed to add "exclusionary language" to it, priority is not at issue with respect to the mark and goods and services identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

A. Strength of Opposer’s Mark

The parties barely mention the strength of Opposer’s mark, and do not cite to any evidence on the question. 51 TTABVUE 21-22; 53 TTABVUE 26-28. Opposer claims, and Applicant does not dispute, that the parties’ marks “are the only STRATIO marks appearing on the register.” 51 TTABVUE 21. Opposer also claims, without explanation or support, that its mark is “arbitrary” and “fanciful.” *Id.* at 21-22.

Applicant points out that “the record is completely devoid of any evidence that Opposer’s mark enjoys any commercial strength.” 53 TTABVUE 27. Applicant also disputes that Opposer’s mark is arbitrary, suggests that it may convey some industry-related meaning, and points out that “[e]vidence that an element of a mark is commonly adopted may indicate that the common element has some non-source identifying significance;” Applicant does not cite any evidence that relates to the conceptual strength of Opposer’s mark, however. *Id.*

We find that Opposer’s pleaded STRATIO mark is entitled to the typical scope of protection accorded inherently distinctive marks that have not been shown to be commercially strong.

B. The Marks

The marks (STRATIO and  are obviously quite similar in “appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *Du Pont*, 177 USPQ at 567). Indeed, the only difference between them is that Applicant’s mark includes “a red circle in the middle of a semi-circle which is orange on one side and moves into being dark red and then red” This

distinction does not make a meaningful difference, primarily because the dominant portion of Applicant's mark is legally identical to Opposer's mark.

Here, as is typically the case, the design element of Applicant's mark is not nearly as significant as the mark's literal element, because consumers are likely to call for Applicant's goods and services by the term "STRATIO." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) ("the verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that "if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services" and "because applicant's mark shares with registrant's mark that element responsible for creating its overall commercial impression, the marks are confusingly similar"). Obviously, when consumers use "STRATIO" to call for Applicant's goods and services, the mark will sound identical to Opposer's.

While the circle and semicircle in Applicant's mark make it look a little different than Opposer's mark, the design element of Applicant's mark is pedestrian, and not sufficiently distinctive or distinguishing to avoid confusion. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1138 (TTAB 2015); *National Rural Elec. Cooperative Ass'n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1883 (TTAB 2006), *aff'd*, 214 Fed. Appx. 987 (Fed. Cir. 2007) ("The circle design is hardly particularly distinctive in trademark designs."); *In re Anton/Bauer, Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) ("common geometric shapes such as circles, ovals, triangles, diamonds

and stars, when used as backgrounds for the display of word or letter marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone”). In fact, consumers could very well perceive Applicant’s mark as a version of Opposer’s that includes a logo or design.

There is no evidence that the marks’ shared term STRATIO has any meaning known to consumers, and Mr. Funes testified that it has no “particular significance.” 40 TTABVUE 12 (Funes Tr. 8).⁹ In any event, there is no evidence or reason to believe that the shared term would have one meaning when used for Opposer’s goods and services, and another when used for Applicant’s. We find that the term STRATIO conveys the same meaning and creates the same commercial impression in both marks, and neither party argues to the contrary.

In short, the marks are highly similar and this weighs heavily in favor of finding a likelihood of confusion.

C. Consumer Sophistication and Care

Applicant argues that its goods and services “are purchased by highly sophisticated consumers who exercise great care in their purchasing decisions ... consumers can be expected to exercise diligence and caution in making their selections.” 53 TTABVUE 28. We agree that this factor weighs in Applicant’s favor.

⁹ Mr. Funes testified that when Opposer chose its pleaded mark the things that “came to mind” were “Strata, as the idea of a layer related to data, and also IO, as the input/output. This is also used a lot in technology. So if you mix both of them, you get the Stratio.” 40 TTABVUE 13 (Funes Tr. 9). There is no evidence that consumers are aware of what “came to [Opposer’s or Mr. Funes’s] mind.”

Applicant’s “prospective customers must engage directly with [Applicant] to purchase” Applicant’s goods and services. 46 TTABVUE 4 (Margalho Dec. ¶ 8). This includes clients “providing at least a minimum level of information regarding the client’s specific operation type (e.g. urban transport, inter-urban, school bus, etc.), as well as the number and type of vehicles (including technology used – internal combustion engine, EV, Fuel Cell EV, CNG, etc.) with which the products and services are to be used.” *Id.* at 4-5 (Margalho Dec. ¶ 9). Furthermore, the “individuals responsible for making purchasing decisions regarding [Applicant’s] goods and services” are “typically responsible” for fleet maintenance, which we can infer means that they are responsible, perhaps indirectly, for passenger safety. *Id.* at 5 (Margalho Dec. ¶ 12). Applicant’s products and services are relatively expensive, though the specific figures provided were designated “Confidential,” and so are not provided in this decision. 45 TTABVUE 6 (Margalho Dec. ¶ 13). “Purchasing decisions typically take between 6 months and 1 year and often involve dozens of interactions (meetings/phone calls/pitches/presentations) between [Applicant] and the client.” 46 TTABVUE 6 (Margalho Dec. ¶ 15).

This type of evidence has been found on a number of occasions to weigh against a finding of likelihood of confusion. *See e.g. Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391-92 (Fed. Cir. 1992); *Embarcadero Tech., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1838-39 (TTAB 2013). We find that it does so here as well.

While there is no evidence that Opposer's potential customers are also careful or sophisticated, we infer from Opposer's identification of goods and services that they are, at least to some extent. As identified, Opposer's software and data services are exclusively or at least primarily targeted to businesses, and would be expected to be used in connection with important business assets. Technical or business skills or knowledge may very well be required to understand and use Opposer's goods and services.

This factor weighs against finding a likelihood of confusion.

D. The Lack of Actual Confusion

Applicant "is aware of no instances of actual confusion with either [Opposer] or its offerings in the United States." 46 TTABVUE 8 (Margalho Dec. ¶ 33). This is irrelevant.

Indeed, Applicant filed the involved application based on an intent to use the mark in commerce, and more to the point there is no evidence regarding the extent of the parties' use (if any) of their STRATIO marks in the United States. Therefore, we cannot gauge whether or the extent to which there has been an opportunity for confusion to occur if it were likely to occur. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF's use of the VITTORIO RICCI mark on the merchandise in question in prior years"); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). "[I]t is unnecessary to show actual confusion in

establishing likelihood of confusion.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). This factor is neutral.

E. The Goods and Services and Their Channels of Trade and Classes of Consumers

We first address the parties’ current identifications of goods and services, and then turn to Applicant’s alternative argument based on its proposed amended identifications.

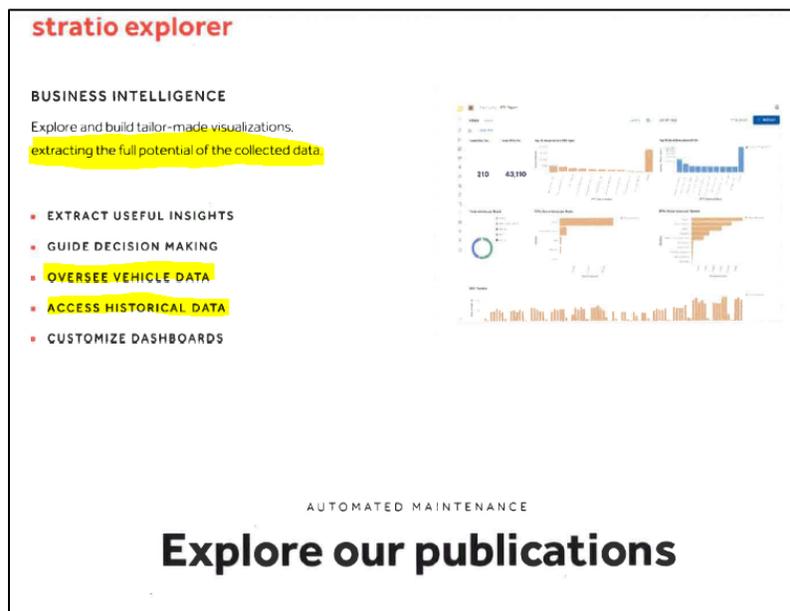
1. The Current Identifications of Goods and Services

Opposer’s identified “computer software for the collection, editing, organizing, modifying, analyzing and generation of reports of data and information” in Class 9 is broad enough to encompass Applicant’s identified “downloadable software for measuring, detecting and monitoring of automotive performance” in the same class. Indeed, “data and information” is so broad that it includes data and information about “automotive performance.” Thus, these goods are legally identical. It is sufficient for a finding of likelihood of confusion that identity is established for any item encompassed by the identification of goods in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

As for Applicant’s Class 37 services, they include “information and consultancy services relating to vehicle repair,” while “data mining” is identified, without limitation, among Opposer’s Class 42 services. Applicant’s “information and consultancy services” are identified broadly, such that the “information services” could include information obtained from “data mining” related to vehicle repair. To that extent, the services could potentially overlap. At the very least, vehicle owners

and operators seeking information on their vehicles' condition could be exposed to both Applicant's and Opposer's information services, and given the close similarity of the marks, become confused. Thus, there is a relationship between the parties' services.

Corroborating this relationship, Mr. Margalho testified that Applicant's goods and services utilize "both hardware and software to **collect and analyze vehicular data** for use in failure detection and predictive alerts." 46 TTABVUE 4 (Margalho Dec. ¶ 4) (emphasis added). Applicant's website touts not only Applicant's use of "artificial intelligence" as applied to data, 24 TTABVUE 84, but also its "extracting the full potential of the collected data," which sounds fairly similar to "data mining":



24 TTABVUE 86 (highlighting added). It also features a diagram indicating that Applicant's "databox" and "data logger" are responsible for "data acquisition," and that the collected data is analyzed. *Id.* at 91. Applicant issued a press release touting its "AI" goods and services that quotes an investor as saying that Applicant "is one of

the most exciting companies in our portfolio of data-driven enterprise software businesses.” 27 TTABVUE 5. A report on “Big Data in the Automotive Industry” lists Applicant as a “vendor.” *Id.* at 20. One of Applicant’s software developers wrote an article entitled “Stratio Software Journey,” and one of its data scientists wrote an article about “Stratio – AI Cortex.” *Id.* at 23-35. *See also* 48 TTABVUE.

In short, Applicant’s Class 9 goods are legally identical to Opposer’s Class 9 goods, and Applicant’s Class 37 services are at least related to Opposer’s Class 42 “data mining” services.

Moreover, the evidence reveals that the channels of trade and classes of consumers for software and data collection and analysis at times overlap with those for vehicle and fleet-related products and services. In addition to consumer perceptions discussed and propagated in the report on “Big Data in the Automotive Industry,” 27 TTABVUE 5, the Pipeline Magazine article “Putting Telematics in the Big Data Driver’s Seat” discusses and propagates the idea “data” is “the crux to keep transportation doing its job to move goods.” 47 TTABVUE 210. In fact, the Pipeline article states: “By processing, storing, and sending data between vehicles and end users through telecommunication devices, telematics can help fleet managers understand where and how a vehicle is being driven, how to best optimize or redirect routes for productivity and efficiencies, and where improvements can be made in accident prevention measures and driver safety standards.” 47 TTABVUE 210.

While Applicant disputes that the channels of trade or classes of consumers overlap, it acknowledges at the same time that “‘technology’ is a very broad category

that encompasses a wide variety of disparate and non-competitive products and services.” 53 TTABVUE 35. This is reflected in Opposer’s broad targeting of its goods and services, which “can be used by virtually any industry.” 23 TTABVUE 3 (Funes Dec. ¶¶ 11-12). Thus, while we take Applicant’s point that Opposer offers “a backend technology platform and related products/services,” 53 TTABVUE 17, 22, 25, 33, vehicle fleet managers and other potential consumers of Applicant’s products and services could be potential consumers for Opposer’s “backend” goods and services. Those consumers could encounter both parties’ goods and services in technology-focused channels of trade, and, because Applicant and Opposer both offer data and AI technology under the mark STRATIO, could be confused as to the source of the parties’ goods and services.

These factors therefore also weigh in favor of finding a likelihood of confusion as to the parties’ goods and services as currently identified.¹⁰

2. Applicant’s Proposed Modifications to the Parties’ Identifications of Goods and Services

We first address Applicant’s motion to amend its own application, and then turn to its Section 18 counterclaim.

a. Applicant’s Motion to Amend the Involved Application

In its pretrial motion to amend the involved application, 11 TTABVUE 6-8, Applicant seeks to delete all of the Class 12 goods, delete the software goods from

¹⁰ There is no evidence establishing that any of Applicant’s other identified goods and services are related to, or travel in the same channels of trade to the same classes of consumers as, any of Opposer’s other identified goods and services, and we therefore do not find any relationship or overlap in trade channels or consumers for Applicant’s other goods and services.

Class 9 and delete additional goods and services from Classes 9 and 37, as follows

(proposed deletions in **bold** and ~~strikethrough~~):

~~computer software for remote monitoring of devices for measuring automotive vehicle performance; downloadable software for measuring, detecting and monitoring of automotive performance; instruments for measuring, detecting and monitoring of land vehicle performance namely namely water temperature gauges, air fuel/ratio gauges, boost gauges, vacuum gauges, exhaust gas temperature gauges, oil pressure gauges, oil temperature gauges, coolant temperature gauges or engine RPM gauges; diagnostic apparatus for testing automobiles; sensors and detectors for measuring, detecting and monitoring automotive land vehicles performance namely of oil pressure sensor, oil temperature sensor, coolant temperature sensor or engine RPM sensors; electronic controls for gasoline, diesel or electric engines for monitoring and checking motor vehicle and engine performance for repair and maintenance needs; electric wire harnesses for vehicle repair and maintenance; vehicle electronic controls to remotely monitor and control motor vehicle engine systems, energy systems, lighting systems, braking systems, climate systems, or fuel systems, in International Class 9;~~

~~land vehicle structural parts; land vehicle parts in the nature of wire harnesses, namely, wires, terminals and connectors bundled together to transmit electric power and signals to electric or electronic equipment mounted on the body parts of automobiles; land vehicle console parts, namely, wiring harnesses for control, monitoring and protection of industrial gasoline and diesel engines; sensors for land vehicles, namely, electric power steering torque sensors, sold as a component of the power steering system; anti-theft, security and safety devices and equipment for vehicles namely anti-theft alarms and anti-theft devices for vehicles; back-up warning alarms for vehicles; motor vehicle alarm systems, in International Class 12; and~~

~~vehicle service, repair, maintenance and refueling; inspection of automobiles and their parts prior to maintenance and repair;~~ arranging for the maintenance of motor land vehicles; providing information relating to the repair of land vehicles; information and consultancy services relating to vehicle repair; advisory services relating to the maintenance and repair of vehicles; consultancy relating to the repair, maintenance and refueling of vehicles, in International Class 37.

Thus, Applicant's proposed amendment would delete the Class 9 goods we found legally identical to Opposer's Class 9 goods, but leave in place the Class 37 services we found to be at least related to Opposer's "data mining" services in Class 42.

In its pretrial response to Applicant's motion to amend the involved application, Opposer argued that the "amendment should not be permitted absent a judgment in favor of Opposer as to the deleted goods and services." 12 TTABVUE 3. Applicant replied that it was "not obligated to consent to judgment as to the requested deleted goods at this stage of the proceedings," and made clear that it sought consideration of the proposed amendment, if necessary, after the trial was completed, at final decision. 15 TTABVUE 2-3.

While Applicant has not explicitly consented to judgment as to the deleted goods, it seemed to implicitly provide its consent to judgment at final decision in the event its motion to amend was found to avoid any likelihood of confusion that would arise out of its original identification of goods and services. In any event, in this final decision, we may grant the motion to amend without Opposer's consent. Trademark Rule 2.133(a) ("An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed

in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, **or** upon motion granted by the Board.”) (emphasis added).

Applicant’s motion to amend its involved application is granted. It not only narrows Applicant’s goods and services, but does so in a way as to avoid confusion between the parties’ Class 9 goods. As indicated, it deletes the “downloadable software for measuring, detecting and monitoring of automotive performance” which we found to be confusingly similar to Opposer’s Class 9 “computer software for the collection, editing, organizing, modifying, analyzing and generation of reports of data and information.” *See Embarcadero Tech.*, 105 USPQ2d at 1838-39 (granting the applicant’s motion to amend (narrow) its involved application in a way that would avoid a likelihood of confusion).

While Applicant did not consent to judgment with respect to its deleted goods, here entering judgment is appropriate. Opposer challenged registration for the now-deleted goods, and pursued its challenge through trial. Applicant should not be able to escape judgment as to certain goods and services merely by deleting them prior to final decision. Indeed, “[t]he purpose of entering judgment on the deleted goods is to ‘preclude [Applicant] from seeking to register its mark at a later date for the goods ... deleted from the original identification.’” *Brooklyn Brewery Corp. v. Brooklyn Brew Shop*, 17 F.4th 129, 2021 USPQ2d 1069 at *6-7 (Fed. Cir. 2021) (quoting *Int’l Harvester Co. v. Int’l Tel. & Tel. Corp.*, 208 USPQ 940 (TTAB 1980)). Moreover, here,

as in *Brooklyn Brewery*, Applicant “makes no argument as to why entry of judgment on the deleted goods would be inappropriate” *Id.*

While Applicant’s amendment does not also impact our findings with respect to Applicant’s Class 37 services, we consider below whether Applicant’s alternative Section 18 counterclaim to partially cancel Opposer’s pleaded registration does so.

b. Applicant’s Section 18 Counterclaim for Partial Cancellation of the Pledaded Registration

We find that Applicant’s proposed exclusionary language (“none of the foregoing in connection with the repair, diagnosis or maintenance of vehicles”) changes the calculus with respect to whether there is a relationship between Applicant’s Class 37 “information and consultancy services” and Opposer’s Class 42 “data mining” services, and whether those services travel in the same channels of trade to the same consumers.

Specifically, if the limitation is added, Applicant’s “information and consultancy services,” all of which are “relating to vehicle repair,” would no longer potentially overlap with Opposer’s identified “data mining” services, because Opposer’s data mining services would no longer potentially be “in connection with the repair ... of vehicles.” Similarly, the trade channels and classes of consumers would no longer potentially overlap, because Applicant intends to offer its information services in only the vehicle repair trade channel, to consumers seeking vehicle repair-related services. By contrast, Opposer’s services would be limited to trade channels other than those for vehicle repair, and would be offered to consumers who are not seeking vehicle repair-related services.

VI. Conclusion

The marks are quite similar, which weighs in favor of finding a likelihood of confusion, while the relevant consumers are sophisticated and careful, which weighs against a finding of likely confusion. This decision thus turns on the goods and services, channels of trade and classes of consumers.

Because we have granted Applicant's motion to amend its identification of goods in Class 9, confusion is now unlikely between the parties' Class 9 goods. While there is enough of a relationship between one of Applicant's Class 37 services and one of Opposer's Class 42 services (as the parties' services are currently identified) that confusion is likely, we have granted Applicant's alternative Section 18 counterclaim because it eliminates, through exclusionary language, that likelihood of confusion.

As a result, the parties' identifications of goods and services are amended as follows:

Applicant's Goods and Services:

~~computer software for remote monitoring of devices for measuring automotive vehicle performance; downloadable software for measuring, detecting and monitoring of automotive performance; instruments for measuring, detecting and monitoring of land vehicle performance namely water temperature gauges, air fuel/ratio gauges, boost gauges, vacuum gauges, exhaust gas temperature gauges, oil pressure gauges, oil temperature gauges, coolant temperature gauges or engine RPM gauges; diagnostic apparatus for testing automobiles; sensors and detectors for measuring, detecting and monitoring automotive land vehicles performance namely of oil pressure sensor, oil temperature sensor, coolant temperature sensor or engine RPM sensors; electronic controls for gasoline, diesel or electric engines for monitoring and checking motor vehicle~~

~~and engine performance for repair and maintenance needs; electric wire harnesses for vehicle repair and maintenance; vehicle electronic controls to remotely monitor and control motor vehicle engine systems, energy systems, lighting systems, braking systems, climate systems, or fuel systems, in International Class 9;~~

~~land vehicle structural parts; land vehicle parts in the nature of wire harnesses, namely, wires, terminals and connectors bundled together to transmit electric power and signals to electric or electronic equipment mounted on the body parts of automobiles; land vehicle console parts, namely, wiring harnesses for control, monitoring and protection of industrial gasoline and diesel engines; sensors for land vehicles, namely, electric power steering torque sensors, sold as a component of the power steering system; anti-theft, security and safety devices and equipment for vehicles namely anti-theft alarms and anti-theft devices for vehicles; back-up warning alarms for vehicles; motor vehicle alarm systems, in International Class 12; and~~

~~vehicle service, repair, maintenance and refueling; inspection of automobiles and their parts prior to maintenance and repair;~~ arranging for the maintenance of motor land vehicles; providing information relating to the repair of land vehicles; information and consultancy services relating to vehicle repair; advisory services relating to the maintenance and repair of vehicles; consultancy relating to the repair, maintenance and refueling of vehicles, in International Class 37.

Opposer's Goods and Services:

computer software for use in the field of business intelligence gathering and management, business analytics, software application monitoring and analysis, web content customization and target marketing; computer software for the collection, editing, organizing, modifying, analyzing and generation of reports of data and information; **none of the foregoing in connection with**

the repair, diagnosis or maintenance of vehicles, in International Class 9;

data processing services, in International Class 35; and

data mining; data warehousing; software development in the field of business intelligence, business analytics, software application monitoring and analysis, web content customization and target marketing; information technology consulting services in the field of business intelligence, business analytics, software application monitoring and analysis, web content customization and target marketing; **none of the foregoing in connection with the repair, diagnosis or maintenance of vehicles**, in International Class 42.

Decision: The opposition is dismissed. Applicant's motion to amend its identification of goods and services, and its alternative Section 18 counterclaim to partially cancel Opposer's pleaded registration, are both granted. Judgment is entered as to the goods Applicant deleted from its involved application.